

REMARKS

Applicants respectfully thank the Examiner for finding the previous amendment persuasive and withdrawing the previous rejections.

Claim 1 has been amended to remove reference to vanillin.

Care has been taken not to introduce any new matter.

The Present Invention

The present invention addresses the problem of providing an alternative treatment for the signs of aging by employing a unique combination of retinoid, retinoid booster, and phytoestrogen. However, it has been discovered that *boosters* and *phytoestrogens*, while boosting the benefits of retinoids, destabilize the retinoid by inducing oxidation of retinol. The present invention addresses the problem of providing a *stable product with maximum efficacy*, by preventing any undesired interaction of the retinoid and the boosting agents and the phytoestrogens during storage.

The Present Invention is Not Obvious under 35 USC § 103

Claims 1-2 and 5-6 were rejected under 35 USC § 103 as being unpatentable over Cohen et al., *Sichak*, Weidenboerner et al. (337), in view of Suares et al.

According to the Office Action, Cohen et al., *Sichak*, and Weidenboerner et al., teach the claimed compounds retinoic acid, vanillin, isoflavones (*phytoestrogens*),

respectively, as useful for treating fungal infections.; Claims 1-2 and 5-6, and the primary references, differ as to :

- 1) the concomitant employment of these medicaments.
- 2) administration levels of the medicaments, and
- 3) administration of the medicaments in separate containers.

Applicants respectfully traverse this rejection. Regarding difference (1), firstly, there is not suggestion or motivation to combine the references and, secondly, Applicants have shown unexpected results in the combination of ingredients, i.e. synergistic results from combination of retinoid and boosters and phytoestrogen. Regarding difference (2), Applicants have claimed cosmetically effective amounts. Regarding difference (3), the particular means by which the compositions are separated is new and inventive, and critically contributes to the stability of retinoids without compromising overall efficacy.

Additionally, Applicants respectfully submit that claim 1, as amended, and claim 2 recite a specific list of different boosters and a specific list of different phytoestrogens than those disclosed in the cited references.

"1) the concomitant employment of" the claimed components
does not constitute "the same use"

An issue presented in the Final Office Action is whether the combination of references, each disclosing efficacy for a different fungus, constitutes "the same use", especially when the inventive composition addresses a completely different problem than the cited references.

Applicants respectfully submit that the combination of references does not demonstrate "the same use" and there is no suggestion or motivation to combine the

references. Each of the four cited references addresses a different compound, each having anti-fungal activity toward different fungi. In fact, the references teach away from the combination, as it is evident from the references alone or in combination that different agents have anti-fungal activities toward different fungi, and there is no reason provided to believe that a material having anti-fungal activity toward one particular fungus will also have anti-fungal activity toward a different fungus. Accordingly, there is no suggestion that all anti-fungal agents have activity against all fungi and, therefore, no suggestion or motivation for combining anti-fungal agents and/or the references that disclose them.

The present case is distinguishable from that cited in the Office Action. In re Kerhoven, 205 U.S.P.Q. 1069 (C.C.P.A. 1980) found it to be *prima facie* obvious to combine two known compositions, both known to be useful for the same purpose, in order to form a third composition that is to be used for the very same purpose. The idea of combining them flowed logically from their having been individually taught in the prior art. In contrast, none of the components of the compositions of the present invention, either individually or in combination, are taught to be useful as stable skin care products and/or as effective in the same field of skin and/or as effective for the same fungus. The claims are limited to stable skin care products and to boosting a benefit of retinoids. In the present case, it would not be logical to use the particular claimed retinoids, boosters, and phytoestrogens because one skilled in the art would not expect them all to be effective for the same benefit. Specifically, the retinoids of Cohen et al. are disclosed for several fungi that affect blood in mice (but not disclosure of *Aspergillus* is present). Sichak et al. disclose vanillin as anti-fungal for athlete's foot. Weidenboerner et al. disclose isoflavones as an anti-fungal for storage fungus of *Aspergillus*. The actives are different; the fields of use are different; combination of the references does not flow logically. Therefore, the present case is different from In

re Kerhoven, and the Office Action fails to demonstrate a *prima facie* case of obviousness.

Evidence of Unexpected, Synergistic, Results Must Be Considered

Applicants do not consider that the Examiner has set forth a *prima facie* case of obviousness. Even if such a case had been set forth, applicants have demonstrated unexpected results. Applicants have demonstrated strong synergies in the combination of retinoids with phytoestrogens. See Specification, Tables 4 and 5 at pp. 48-49. At the same time, Applicants have demonstrated that phytoestrogens contribute to loss of stability of retinoids and therefore require a dual compartment package. See Specification, Example 5, Tables 6 and 7. These are *clear and convincing*, unexpected results, rebutting any *prima facie* case of obviousness if it had been made out.

Furthermore, Applicants are submitting herewith a Rule 132 Declaration in support of strong synergies of retinoids with B2 and B3 boosters. In particular, the data show a more than additive effect of Glycyrrhetic acid and Phosphatidyl choline (B2) in boosting retinol activity to inhibit transglutaminase production. The accompanying Declaration supports unexpected results as claimed; particularly, in claims 2 and 6.

Additionally, the combination of the cited documents fails to disclose the particular boosters and phytoestrogens claimed in claims 1 and 2, either alone or in combination with retinoids.

3) Dual Compartment Package is Not obvious

Storage of the compositions in separate containers is novel and unobvious because None of the cited documents addresses the problem of retinoid stability in the presence of phytoestrogens and/or boosters. Consequently, there is no suggestion for a person skilled in the art to try to physically separate the retinoids, the boosters, and the phytoestrogens. For example, Table 1 at page 40 of the Specification shows that glycerhetinic acid contributes to 1.6-fold and linoleic acid contributes to 3.4-fold increase in the rate of retinol loss. Absent the hindsight of Applicants' specification, there would be no suggestion or motivation for one skilled in the art to separate the retinoid and booster compositions.

In particular, none of the cited references teaches or suggests a two-part composition which contains in one part a retinoid, and in the second part a retinoid booster and a phytoestrogen. As discussed above, Cohen et al., Weidenboerner et al., do not teach or suggest the combination of components claimed presently, i.e., retinoid + booster + phytoestrogen. There is no teaching or suggestion of how to put these components together to achieve a stable skin care product. Suares et al. do not remedy the defect because they fail to teach or suggest which combinations of components are placed together and which are kept separate. Only with the hindsight of the present invention is this combination possible.

Suarez et al. (USPN 5,914,116) *teach away from the present invention.* Suares et al. disclose two separate containers for separating two different skin actives **for two different benefits**, with one container containing a first active providing a first benefit and the second containing a second active providing a second and different benefit. See Suares et al at col. 11, lines 13-15 (" ... the first and second actives and benefits

being different from one another... "). Furthermore, Suares et al. fail to disclose the need to separate phytoestrogens from retinoids. In contrast, the present invention is directed to two separate compositions with one intended to boost the benefit of the other. According to the present invention, the two compositions are intended to be applied simultaneously or consecutively, but are kept separately for stability reasons. Independent claim 5, as worded to relate to "first benefit", is intended to clearly convey that the specified retinoids and the phytoestrogens, although separated into two compartments, are there for the same benefit (as compared with the cited art). The first composition provides a first benefit to the skin while the second composition works to boost or enhance the effect of the first benefit.

As such, Suares et al *teach away from the present invention* and fail to provide a suggestion or motivation for the particular way the compositions of the present invention are stored separately.

CONCLUSION

The Office Action has combined Cohen et al. with Sichak, Weidenboerner '337 and Suares et al. and has concluded that the claimed invention is obvious. Even if it was not clear prior to the present Amendment, it is now clear that there is no motivation to combine the references. Some teaching, suggestion, or incentive supporting combination of multiple references must be shown in order to prove obviousness. In re Gaiger, 815 F.2d 686 (Fed. Cir. 1987); ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

An obviousness rejection is proper only when "the subject matter as a whole would have been obvious at the time the invention was made ..." (emphasis added). 35

U.S.C. 103. Applicants respectfully submit that the Office Action has improperly chosen certain aspects of one reference and combined them with aspects of other references, without showing where the motivation is to combine them to come up with the subject matter of the present invention as a whole, within the meaning of 35 U.S.C. 103. Applicants submit that the pending claims are not obvious over the cited references, under 35 U.S.C. 103, especially in view of the present Amendment. Reconsideration and withdrawal of the rejection is respectfully requested.

Reconsideration of the rejection is respectfully requested in view of the above claim amendments and remarks.

It is respectfully requested that the application be allowed to issue.

If a telephone conversation would be of assistance, Applicant's undersigned attorney invites the Examiner to telephone at the number provided.

Respectfully submitted,


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